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10/772,031	02/03/2004	Hank Risan	MOMI-018	3883

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EXAMINER
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KIM, JUNG W

ART UNIT	PAPER NUMBER
2132	

MAIL DATE	DELIVERY MODE
12/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/772,031

Applicant(s)

RISAN ET AL.

Examiner

Jung Kim

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-31 are pending.
2. This Office action is in response to the amendment filed on 10/1/07.

#### ***Response to Amendment***

3. The objection to claim 21 is withdrawn as the amendment overcomes the objection.
4. The 112/2nd paragraph rejections to claims 2-4 are withdrawn as the amendment overcomes the 112/2nd paragraph rejections.

#### ***Response to Arguments***

5. Applicant's argument with respect to the 112/2<sup>nd</sup> paragraph rejection for the use of the trademark "Macintosh" has been fully considered but they are not persuasive. Applicant points to MPEP 2173.05(u) as a basis for rebuttal. ("The presence of a trademark or trade name in a claim is not, per se, improper under 35 U.S.C. 112, second paragraph.") However, the remainder of 2173.05(u) articulates a basis when a trademark is improperly used in a claim: "If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material

or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name." As currently construed in the claims, the limitation "Macintosh operating system" is used to identify or describe a particular material or product. Moreover, applicant claims that the use of the "trademark 'Macintosh' with further reference to an operating system characteristics has a fixed and definite meaning to provide sufficient identification of the operating characteristics" (Remarks, pg. 9) as required under 35 USC 112; however applicant does not clarify what these characteristics are; applicant merely makes a bald conclusion that such a use has a fixed and definite meaning. On the contrary, the Apple Corporation has produced various Macintosh operating systems over the course of its existence beginning with the original Classic and continuing today with its UNIX style memory management feature. Such a broad range of operating systems hardly defines a fixed and definite meaning as required under 35 USC 112; rather, the use of the trademark suggest a limitation to identify or describe a particular material or product.

6. With respect to the 102 rejections of claims 1, 5-7, 9-13, 16-24 and 26-31, applicant claims that Wiser does not anticipate the limitations "the compliance mechanism comprising: a framework for validating the compliance mechanism on the client system; and a multimedia component opened by the framework, the multimedia component for decrypting the media content on the client system." (pg. 10) Applicant

argues "[i]n contrast, Applicants understand Wiser et al. to teach an online music distribution system including a variety of cooperative components that communicate over a public network, such as the Internet." (Ibid) Applicant's arguments have been considered, but are not persuasive. Applicant's interpretation glosses over the features of Wiser relevant to the limitations of claim. In particular, Wiser discloses a compliance mechanism including a Passport (col. 8:42-9:36); Media Data files (col. 6:48-8:41), wherein each Media Data file includes a transaction ID that is used to uniquely identify each copy of a media data file that is published; Media Player (col. 10:1-16), wherein the media player validates the passport and a voucher ID, and if successfully validated, then decrypts the media content. (col. 19:50-60) These protective features of Wiser appear to describe a compliance mechanism including a framework to validate the compliance mechanism (means to validate the various security requirements including a transaction ID, the passport, and the voucher ID); and a multimedia component for decrypting the media content on the client system (the media player). Hence, under the broadest reasonable interpretation of the claims (MPEP 2111), Wiser anticipates the limitations of the claims.

7. Further, applicant claims that Wiser does not disclose "preventing decryption of the media content on the client system having the Macintosh operating system operating thereon if a portion of the compliance mechanism is invalidated" because Wiser does not disclose validating the multimedia component. (Remarks, pg. 10, last sentence) In response, it is noted that the features upon which applicant relies (i.e., validating the multimedia component) are not recited in the rejected claim(s). Although

the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As outlined in the rejections below, Wiser discloses that the media content is decrypted only when various security requirements are validated (for example, the checks on the voucher ID and certificate of the passport). It is further noted that contrary to applicant's allegations, Miser does indeed disclose validating the multimedia component. (col. 3:37-39)

8. Applicant's arguments that Wiser does not disclose "a kernel level extension providing kernel level driver information to said framework" as recited in claims 12 and 23 (Remarks, pg. 11) is not persuasive for the following reason: the limitation of these claims only describes generally a kernel level extension to provide driver information to the framework without specify any other limitation, or the extent to which the information is provided to the framework by the kernel level extension; because Wiser's framework interacts with the physical components of the computer (Wiser device protects the reproduction of music) a kernel level extension providing a kernel level driver is necessary to communicate with the framework. It is further noted that the depending claims which provide more limiting features of the kernel level extension is rejected as being obvious in view of Wiser and Curran as outlined below.

9. Finally, in response to applicant's argument that the Official Notice given for the rejection of claim 8 is insufficient because 1) "the Office Action has not stated why the

teachings of a bad boy list in conjunction with the playback is common knowledge" and 2) the Office Action has not stated how such teachings relate to the claims," (Remarks, pg. 13) these arguments are not persuasive, because the rejections do in fact provide factual evidence that the bad boy list in conjunction with the playback is common knowledge ("[I]t is notoriously well known in the art for a security module to include a list of executables/processes; such a list is used to prevent malware from being run on the system. For example, McAfee and Symantec are two security programs that maintain a list of possible viruses to ensure that such software does not run on the machine." [paragraph 18 of Office action mailed on 6/27/07]), and the Office Action state how the teachings relate to the claims ("Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the compliance mechanism to further comprise a bad boy list. One would be motivated to do so to prevent malware from executing on the computer as known to one of ordinary skill in the art. The aforementioned cover the limitations of claim 8") Moreover, applicant's argument does not provide any statement why the noticed fact is not considered to be common knowledge or well-known in the art. (MPEP 2144.03: "To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b) ...If applicant does not traverse the examiner's assertion of Official Notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art

because applicant either failed to traverse the examiner's assertion of Official Notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. [emphasis added]) Hence, applicant's traversal is inadequate, and the Official Notice is sustained.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. As per claims 1-31, the presence of the trademark "Macintosh" is not proper under 35 U.S.C. 112, second paragraph (see MPEP 2173.05(u)).

7. The trademark "Macintosh" is used in the claim as a limitation to identify or describe a particular material or product (Macintosh operating system); hence the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982).

***Claim Rejections - 35 USC § 102***

12. Claims 1, 5-7, 9-13, 16-24 and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiser et al. USPN 6,385,596 (hereinafter Wiser).

13. As per claims 1, 5-7 and 9-11, Wiser discloses a method for preventing unauthorized recording of media content on a Macintosh operating system comprising:



- a. registering a compliance mechanism on a client system having said Macintosh operating system operating thereon (col. 6:8-12; 13:3-35), said compliance mechanism comprising: a framework for validating said compliance mechanism on said client system; and a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; (8:45-9:37) and preventing decryption of said media content on said client system having said Macintosh operating system operating thereon if a portion of said compliance mechanism is invalidated (13:64-14:21);
- b. wherein said framework will disable audio playback from the multimedia component until said components of the compliance mechanism are validated (13:64-14:21);
- c. wherein said framework accesses a network to ensure that said components of the compliance mechanism are up to date (8:67-9:1);
- d. wherein the framework establishes a monitoring thread which maintains a constant search for output devices. (inherent to Macintosh OS)
- e. wherein said multimedia component is a media rendering or processing application (6:47-8:17);
- f. wherein said media content is received from a source coupled with said client system, said source is from the group consisting of: a network, a personal communication device, a satellite radio feed, a cable television radio input, a set-top box, an media device, a media storage device, a media storage device

inserted in a media device player, a media player application, and a media recorder application (fig. 1 and related text);

g. altering said compliance mechanism in response to a change in a usage restriction, said usage restriction comprising a copyright restriction or licensing agreement applicable to said media content. (25:11-48)

14. As per claims 12, 13 and 16-22, Wiser discloses a computer readable medium for storing computer implementable instructions, said instructions for causing a client system to perform a method for preventing unauthorized recording of media content on a Macintosh operating system comprising: registering a compliance mechanism on a client system having said Macintosh operating system operating thereon (col. 6:8-12; 13:3-35), said compliance mechanism comprising:

h. a framework for validating components of said compliance mechanism on said client system; a multimedia component opened by said framework, said multimedia component for preventing decryption of media content on said client system if said framework detects an invalid environment (8:45-9:37); and a kernel level extension providing kernel level driver information to said framework (Mac OS kernel); disabling output of said media content on said client system having said Macintosh operating system operating thereon if a portion of said compliance mechanism is invalidated; (13:64-14:21)

- i. wherein said instructions cause said client system to perform said method further comprising: authorizing said client system to receive said media content; (14:20)
- j. wherein said framework will disable audio playback from the multimedia component until said components of the compliance mechanism are validated; (13:64-14:21)
- k. wherein said framework accesses a network to ensure that said components of the compliance mechanism are up to date; (8:67-9:1)
- l. wherein said framework establishes a monitoring thread which maintains a constant search for output devices; (inherent to Macintosh OS)
- m. wherein said multimedia component is a media rendering or processing application; (6:47-8:17)
- n. wherein said client system performs said method further comprising: accessing an indicator corresponding to said media content for indicating to said compliance mechanism a usage restriction applicable to said media content; (19:50-20:8)
- o. wherein said client system performs said method further comprising: altering said compliance mechanism in response to changes in said usage restriction, said usage restriction a copyright restriction or licensing agreement applicable to said media content; (25:11-48)
- p. wherein said media content is from a source coupled with said client system, wherein said source is from the group consisting of: a network, a

personal communication device, a satellite radio feed, a cable television radio input, a set-top box, an media device, a media storage device, a media storage device inserted in a media device player, a media player application, and a media recorder application. (fig. 1 and related text)

15. As per claims 23, 24 and 26-31, Wiser discloses a system for preventing unauthorized recording of media content on a Macintosh operating system comprising: means for registering a compliance mechanism on a client system having said Macintosh operating system operating thereon (col. 6:8-12; 13:3-35), said compliance mechanism comprising:

q. means for validating components of said compliance mechanism on said client system; means for preventing decryption of media content on said client system if said framework detects an invalid environment; (8:45-9:37) and means for providing kernel level extension information to said framework; and means for disabling output of said media content on said client system having said Macintosh operating system operating thereon if a portion of said compliance mechanism is invalidated; (13:64-14:21)

r. means for authorizing said client system to receive said media content; (14:20)

s. wherein the framework further comprises:

- i. means for disabling audio playback from the multimedia component until said components of the compliance mechanism are validated; (13:64-14:21)
- ii. means for accessing a network to ensure that said components of the compliance mechanism are up to date; (8:67-9:1)
- iii. means for maintaining a constant search for output devices; (inherent to Macintosh OS)
- t. means for accessing an indicator for indicating to said compliance mechanism said usage restriction applicable to said media content, said indicator attached to said media content; (19:50-20:8)
- u. means for altering said compliance mechanism in response to changes in said usage restriction, said usage restriction a copyright restriction or licensing agreement applicable to said media content; (25:11-48)
- v. wherein said media content is from a source coupled with said client system, wherein said source is from the group consisting of: a network, a personal communication device, a satellite radio feed, a cable television radio input, a set-top box, an media device, a media storage device, a media storage device inserted in a media device player, a media player application, and a media recorder application. (fig. 1 and related text)

16. Claims 2-4, 14, 15 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser in view of Curran et al. USPN 4,525,599 (hereinafter Curran).

17. As per claims 2-4, the rejection of claim 1 under 35 USC 102(b) as being anticipated by Wiser is incorporated herein. Wiser does not disclose the method further comprising a valid kernel level extension providing kernel level driver information to the framework, wherein when an invalid kernel level extension is recognized the framework directs the valid kernel level extension to selectively restrict output of the media content; wherein the valid kernel level extension matches no physical device on the client system; wherein the valid kernel level extension comprises recognizing a kernel level recorder capturing an audio stream; and informing the framework of the kernel level recorder. Curran discloses a software protection method for inhibiting capture of audio visual data by monitoring address and data buses to detect a copy of the data by a microprocessor emulator. When a trap condition is detected, the method identifies an invalid program event and switches the encryption/decryption means from a first operating mode to a second operating mode to disable the copying. Col. 1:67-2:64. Such a feature prevents the capture of the audio visual data. Col. 1:41-66. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the method of Wiser to further comprise a valid kernel level extension providing kernel level driver information to the framework, wherein when an invalid kernel level extension is recognized the framework directs the valid kernel level extension to selectively restrict output of the media content; wherein the valid kernel level extension

matches no physical device on the client system; wherein the valid kernel level extension comprises recognizing a kernel level recorder capturing an audio stream; and informing the framework of the kernel level recorder. One would be motivated to do so to prevent data capture when a trap condition is detected. Curran, *ibid*. The aforementioned cover the limitations of claims 2-4.

18. As per claims 14 and 15, they are claims corresponding to claims 2-4 and 12, and they do not teach or define above the information claimed in claims 2-4 and 12. Therefore, claims 14 and 15 are rejected as being unpatentable over Wiser in view of Curran for the same reasons set forth in the rejections of claims 2-4 and 12.

19. As per claim 25, it is a claim corresponding to claims 2-4 and 23, and it does not teach or define above the information claimed in claims 2-4 and 23. Therefore, claim 25 is rejected as being unpatentable over Wiser in view of Curran for the same reasons set forth in the rejections of claims 2-4 and 23.

20. Claims 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser.

21. As per claim 8, the rejection of claim 1 under 35 USC 102(b) as being anticipated by Wiser is incorporated herein. Although Wiser does not disclose the compliance mechanism further comprises a bad boy list, it is notoriously well known in the art for a

security module to include a list of executables/processes; such a list is used to prevent known malware from being run on the system. For example, McAfee and Symantec are two security programs that maintain a list of possible viruses to ensure that such software does not run on the machine. Examiner takes Official Notice of this teaching. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the compliance mechanism to further comprise a bad boy list. One would be motivated to do so to prevent malware from executing on the computer as known to one of ordinary skill in the art. The aforementioned cover the limitations of claim 8.

### ***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Communications Inquiry***



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim  
Examiner  
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